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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re California Fragrance Company

Sams  
Serial No. 74/468,877  
7-1-97

William H. Pavitt, Jr of Beehler & Pavitt for applicant

Edward Nelson, Trademark Examining Attorney, Law Office 107  
(Thomas Lamone, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

California Fragrance Company has filed a trademark  
application to register the mark MUSCLE SOAK for "non-  
medicated bath salts, bath gels and body lotions" and  
"medicated bath salts, bath gels and body lotions."

The Trademark Examining Attorney refused registration  
under Section 2(e)(1) of the Trademark Act, 15 U.S.C.  
1052(e)(1), on the ground that applicant's mark is merely  
descriptive of its goods. Arguing that its mark is not

' Serial No 74/468,877, in International Classes 3 and 5, respectively,  
filed December 13, 1993, based on use of the mark in commerce, alleging  
dates of first use and first use in commerce, in both classes, of 1989

merely descriptive, applicant responded by submitting its statement that its applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), in view of applicant's substantially exclusive and continuous use of the mark in commerce for at least five years.<sup>2</sup> The Examining Attorney found applicant's statement insufficient to establish acquired distinctiveness. In support of its claim, applicant then submitted the declaration of its president, Sharon Christie, that its goods have been promoted and sold under the mark for more than three years in retail stores, that it promotes the mark by providing samples and point of purchase displays<sup>3</sup> to its customers; and that the mark is used on invoices, correspondence and at trade shows; and that customers re-order applicant's product by reference to the mark MUSCLE SOAK. Applicant followed this declaration with a further submission of evidence, including a summary its 1995 sales of its MUSCLE SOAK items sold as part of its Aromafloria product line, copies of letters from three

<sup>2</sup> We consider applicant's submission under Section 2(f) to be in the alternative. Thus, we consider, first, whether the mark is merely descriptive and then, in view of our finding, whether applicant has established that its mark has acquired distinctiveness.

Attached to the declaration is an advertisement characterized by applicant as a sample point of purchase display. In the ad, above the photograph of several MUSCLE SOAK products, is the caption "The after-sport soak."

retailers,<sup>4</sup> and a sample advertisement from an unidentified source.

The Examining Attorney finally refused registration on the grounds that the mark is merely descriptive in connection with the identified goods, under Section 2(e)(1), and applicant has failed to establish that the mark has acquired distinctiveness in connection therewith, under Section 2(f). In support of his contention that MUSCLE SOAK is merely descriptive, the Examining Attorney submitted copies of excerpts of articles from the LEXIS/NEXIS database.<sup>5</sup>

<sup>4</sup> One letter from a salon states, in part, "We use Muscle Soak in our pedicure area" and "Our customers demand and specify Muscle Soak by name when we are out of stock " Two letters are identical and state, in part

Our customers recognize the specific properties that make all AROMAFLORIA products stand out in the marketplace This includes MUSCLE SOAK, whose natural ingredients are specifically chosen to aid tired, aching muscles - and they make this product name directly announce its benefits Our customers ask for MUSCLE SOAK by name

Another letter, which is one of two letters from the same retailer, states, in part

My customers recognize MUSCLE SOAK body lotion, bath gel and bath salts for the specific aromatherapy and healing properties that are delivered by the ingredients Peppermint soothes fatigued muscles and Lemongrass invigorates tired muscles

<sup>5</sup> The Examining Attorney submitted five articles Three of these articles provide us with no useful information regarding the exposure of the consuming public in the United States to the terms at issue, as two articles are from foreign publications and one article is from a newswire service The remaining two articles contain the following statements

H2O also has a collection of fragrant rubs, soaks and oils to relieve muscle tension, with peppermint the key in Muscle Soak bath powder, Massage Oil and Leg and Foot Rubs, which

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

also contain healing menthol, vitamin E, avocado and wheat germ oil [Newsday, August 18, 1994 ]

As with past Klein launches, the five-item body collection will follow in August. Prices range from \$14 for a glycerin soap and deodorant to \$25 for a 18oz muscle soak. The muscle soak is a first for a Calvin Klein men's line [Women's Wear Daily, May 20, 1994 ]

We take judicial notice of the dictionary definitions,<sup>6</sup> submitted by the Examining Attorney with his brief, of the terms MUSCLE and SOAK and, in particular, note that SOAK is defined, in part, as "1.a. To make thoroughly wet or saturated by or as if by placing in liquid. b. To immerse in liquid for a period of time.. 2. To absorb (liquid) through pores or interstices." The Examining Attorney contends that applicant's goods serve to soak the muscles of the human body and, as such, the phrase MUSCLE SOAK has a readily apparent meaning that describes the nature of the goods; that the phrase is highly descriptive in connection with the goods; and that the evidence establishes that the terms SOAK and MUSCLE SOAK are used in the relevant industry to describe goods which are the same as, or similar to, applicant's goods.

Applicant contends that MUSCLE SOAK is, at most, suggestive, that none of the identified goods is a "soak," rather, the goods must be used in conjunction with a soaking process; that applicant was the first to use the term "soak" in connection with these products so that third-party references, as in the LEXIS/NEXIS excerpts, are "merely recent efforts on the part of others to copy applicant's trademark"; that "If [other parties] want to describe their respective products in claiming usefulness for muscle

<sup>6</sup> *The American Heritage Dictionary*, 1982

soaking therapy in conjunction with a bath or hot pack, they can easily do so without using . . . MUSCLE SOAK."

We conclude, based on the evidence of record, that MUSCLE SOAK is merely descriptive in connection with the identified goods. In fact, applicant's own evidence supports the conclusion that the applied-for mark is merely descriptive. We note, first, that applicant's point-of-purchase advertisement uses the term SOAK in a descriptive manner to describe applicant's product as "The After-Sport Soak." We note, also, that the letters from two retailers point to the descriptive nature of the phrase MUSCLE SOAK in their statements that, in reference to applicant's product, "[t]his includes MUSCLE SOAK, whose natural ingredients . . . are specifically chosen to aid tired, aching muscles . . . and they make this product name directly announce its benefits." (Emphasis added.) Applicant, in its brief, admits that its products are used "in the process of soaking one's muscles" and applicant uses the terms MUSCLE and SOAK descriptively in reference to "muscle soaking therapy." By creating a name for its product using the noun form of SOAK, in the phrase MUSCLE SOAK, applicant does not transform merely descriptive wording into a trademark. Applicant's argument that MUSCLE SOAK is not merely descriptive because the goods must be used in conjunction with a soaking process is "a distinction without a difference." Further, as the

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Examining Attorney correctly stated, it is irrelevant that applicant may have been the first company to so describe its product.

It is our view that, when applied to applicant's goods, the term MUSCLE SOAK immediately describes, without conjecture or speculation, a significant feature or function of them, namely that the products are used as soaks for muscles. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term MUSCLE SOAK as it pertains to applicant's goods.

We turn, then, to consider the sufficiency of applicant's claim that its mark has acquired distinctiveness, under Section 2(f) of the Act. In this case we have a mark that is, at least, highly descriptive in connection with the identified goods. Thus, we conclude that more evidence than that which has been offered here would be necessary to establish the acquired distinctiveness of this designation. The greater the degree of descriptiveness, the greater is the evidentiary burden on the applicant to establish acquired distinctiveness.

*Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also: *Restatement*

(Third) of Unfair Competition (1993), Section 13, comment e ["The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness "]

Applicant's declaration of use for more than three years, evidence of sales for a single year, letters from three retailers, and several sample advertisements do not establish that this highly descriptive phrase is viewed by the consuming public as a trademark for applicant's goods.

As the Examining Attorney points out, the letters submitted by applicant are from retailers who sell applicant's goods to consumers. Not only are there very few letters, i e., from only three retailers, but the letters indicate that these retailers have been selling applicant's goods for only between one and two years. Further, these letters from retailers do not evidence the ultimate consumers' recognition of MUSCLE SOAK as a mark.<sup>7</sup> It is

<sup>7</sup> The fact that the three retailers state in their letters that customers ask for applicant's product by name, does not establish evidence as to whether consumers perceive of the term as a trademark or whether they view it as a merely descriptive term



well settled that the assertions of retailers, who know full well from whom they are buying, that they themselves recognize a particular designation as a trademark, cannot serve to establish that members of the purchasing public, who come to the marketplace without such specialized knowledge, would in fact recognize the designation as an indication of origin. *In re Semel*, 189 USPQ 285, 288 (TTAB 1975). See also, *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372, 376 (CCPA 1959); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

We find that MUSCLE SOAK is merely descriptive in connection with the identified goods and, further, that the evidence of record is insufficient to establish that consumers perceive and understand the designation MUSCLE SOAK as a distinctive source indicator.

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Decision: The refusal on the ground that the mark is merely descriptive in connection with the identified goods and that it has not acquired distinctiveness is affirmed.



R. F. Cissel



E. J. Seeherman



C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

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